

Application Serial No. 09/993,429

**REMARKS**

1. Applicant thanks the Examiner for his helpful comments and suggestions.
2. It should be appreciated that Applicant has elected to amend Claims 1, 3, 21, and 31 and to cancel Claims 30, 33, and 34 solely for the purpose of expediting the patent process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which the Applicant considers the invention herein entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.
3. The specification stands objected to under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) as failing to provide proper antecedent basis for the claimed subject matter of newly introduced claim limitations of Claims 1, 21, 33, and 34.

**Claim 1**

- Applicant amends Claim 1 to remove the newly included Claim restrictions reading "wherein said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider". Accordingly, the objection to the specification based upon Claim 1 under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) as failing to provide proper antecedent basis for the claimed subject matter is deemed to be overcome.

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**Claim 21**

Applicant amends Claim 21 to remove the previously included Claim restrictions requiring the transmitter to transmit directly to a computer connected to a Web server. Accordingly, the objection to the specification based upon Claim 21 under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) as failing to provide proper antecedent basis for the claimed subject matter is deemed to be overcome.

**Claims 33 and 34**

Claims 33 and 34 are cancelled from the application.

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4. The drawings stand objected to under 37 C.F.R. § 1.83(a) as not including every feature as specified in Claims 1, 21, 33, and 34.

**Claim 1**

15 The objection to Claim 1 cited by the Examiner is based upon the newly introduced limitation of: "wherein said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider". As described above, the Applicant amended Claim 1 to remove the newly included Claim restrictions reading "wherein said step of transferring  
20 couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider". Accordingly, the objection to the drawings based on Claim 1 under 37 C.F.R. § 1.83(a) as failing to include in the drawings every feature claimed is failing to provide proper antecedent basis for the claimed is deemed to be overcome.

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**Claim 21**

The objection to Claim 21 cited by the Examiner is based upon the newly introduced limitation of: "wherein said step of transferring couples said Bluetooth-

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enabled pen directly to a computer and via said computer to an online service provider". As describe above, the Applicant amended Claim 21 to remove the previously included Claim restrictions requiring the transmitter to transmit directly to a computer connected to a Web server. Accordingly, the objection to the  
5 drawings based upon Claim 21 under 37 C.F.R. § 1.83(a) as failing to include every feature claimed is deemed to be overcome.

**Claims 33 and 34**

As above, Claims 33 and 34 are cancelled from the application.

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5. Claims 1-2, 22-23, 25-28, and 33-34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

**Claim 1**

15 As described above, the Applicant amended Claim 1 to remove the clause reading "wherein said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider", which was cited by the Examiner as lacking support in the written description. Accordingly, the rejection of Claim 1 and dependent Claim 2 under 35 U.S.C. §  
20 112, first paragraph, as failing to comply with the written description requirement is deemed to be overcome.

**Claim 21**

As described above, the Applicant amended Claim 21 to remove claim language  
25 requiring the transmitter to transmit directly to a computer connected to a Web server. Accordingly, the rejection of dependent Claims 22-23 and 25-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the rejection is deemed to be overcome.

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**Claims 33 and 34**

As above, Claims 33 and 34 are cancelled from the application.

- 5 6: Claims 1-4, 6-10, 14, 16-23, 25-30, 40, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent publication no. 2003/0169864 (hereinafter "Lapstun").

**Claim 1**

- 10 Applicant further amends Claim 1 in order to distinguish Claim 1 from the cited art and to clarify the invention. Claim 1 is amended to require the pen to have a tip and to further require the pen to capture motion of the tip of the pen. Support for the amendment is found in the application as filed at least at page 6, lines 17-19 reading in part: "The pen contains the requisite hardware to capture the  
15 motion of the pen, record a digital video of the area above the tip of the pen ...". Lapstun does not teach or suggest a pen having hardware capable of capturing motion of the pen. At best Lapstun at paragraph [0092] teaches an optically imaging pen encoding data sensed on a page. Sensing images on a page is distinctly different than capturing motion of the pen itself. Lapstun optically  
20 images data encoded on the paper while amended Claim 1 captures images of the pen itself eliminating the requirement for specially encoded paper. Accordingly, the rejection of Claim 1 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

**25 Claim 3**

Applicant further amends Claim 3 in order to distinguish Claim 3 from the cited art. Claim 3 is amended to incorporate all of the limitations of current Claim 30 requiring that information is entered and transferred via a pen having a tip and

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the pen having a transmitter device. Claim 3 is further amended to require the step of capturing digitally any of: motion of the pen, video of an area above said tip of said pen, a page number, and an area about half an inch above said tip of said pen. The current amendments to Claim 3 find support in the application as  
5 filed at least at Claim 30; page 6, lines 17-20; and at page 5, line 24 to page 6, line 2. Support for newly include claim elements is underlined in the cited sections.

Page 5, line 24 to page 6, line 2 reads:

10 In one embodiment, when the user writes with the pen on a paper media, the following pieces of information may be captured digitally: a) the motion of the pen itself, b) a digital video of the area above the tip of the pen, and c) the page number encoded in an RF tag embedded into the page, for example.

Page 6, lines 17-20 reads:

15 The pen contains the requisite hardware to capture the motion of the pen, record a digital video of the area above the tip of the pen, e.g. half an inch above the pen, read the RF-tag, and transmit this information wirelessly using the Bluetooth protocol.

Accordingly, the rejection of Claim 3 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

20 **Claim 21**

Applicant further amends Claim 21 in order to distinguish Claim 21 from the cited art and to clarify the invention. Claim 21 is amended to require the pen to have a tip and to further require the pen to capture video of motion of the pen, and still  
25 further require the pen to capture video of an area about half an inch above the tip of the pen. Support for the amendment is found in the application as filed at least at page 6, lines 17-20 reading in part: "The pen contains the requisite hardware to capture the motion of the pen, record a digital video of the area above the tip of the pen, e.g. half an inch above the pen, ...". Lapstun does not  
30 teach or suggest capturing video about half an inch above the tip of the pen.

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Accordingly, the rejection of Claim 21 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

7. Claims 11-13, 15, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as  
5 being unpatentable over Lapstun in view of U.S. patent no. 5,561,446  
(hereinafter "Montlick").

In view of the above described amendments to parent Claims 3 and 21, the  
current rejection of dependent Claims 11-13, 15, 38, and 41 under 35 U.S.C. §  
10 103(a) as being unpatentable over Lapstun in view of Montlick is rendered moot.

8. Claims 31, 32, 35-37, and 39 stand rejected under 35 U.S.C. § 103(a) as  
being unpatentable over Lapstun in view of U.S. patent no. 6,008,727  
(hereinafter "Want").

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In view of the above described amendments to parent Claims 3 and 21, the  
current rejection of dependent Claims 31, 32, 35-37, and 39 under 35 U.S.C. §  
103(a) as being unpatentable over Lapstun in view of Want is rendered moot.

- 20 9. Claim 30 is cancelled from the application.

10. Claim 31 is amended to correct dependencies resulting from the  
cancellation of Claim 30.

- 25 11. New Claims 43 and 44 are added to the application. Support for new  
Claims 43 and 44 is found in the application as filed at least at page 6, lines 17-  
20. Applicant certifies that no new matter was added by way of the new claims.

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**CONCLUSION**

In view of the above, the Application is deemed to be in allowable condition. The Examiner is therefore earnestly requested to withdraw all outstanding objections and rejections, allowing the Application to pass to issue as a United States  
5 Patent. Should the Examiner have any questions regarding the application, he is respectfully urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,



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Michael A. Glenn

Reg. No. 30, 176

Customer No. 22,862